

REMARKS

The Examiner is thanked for the careful consideration provided in the examination of this application. In view of the forgoing amendments and remarks, Applicants respectfully request reconsideration of the claims and withdrawal of the outstanding rejections.

Allowable Subject Matter

The Examiner is thanked for indicating that Claims 1, 3-12 and 17 are allowed.

Double Patenting

Applicant notes the provisional double patenting rejection based on Application Serial No. 10/957,923. However, Applicant will refrain from addressing this rejection until one of the applications goes to issue. Applicant reserves the right to challenge the validity of this double patent rejection.

Rejections Under 35 U.S.C. §103(a)

Claims 13-16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Terbrack et al ("Terbrack", U.S. Patent No. 4,426,820). This rejection is respectfully traversed.

The Official Action takes the position that Terbrack shows a method for manufacturing a floor having mechanically locked floorboards, the floorboards having pairs of opposing connectors 40, 41, 40', 41' along their long sides, and pairs of opposing connectors 40, 41, 40', 41' along their short sides. The Official Action continues to state that Terbrack shows first and second types of floorboards (Figures 11 and 23, respectively), differing from each other by the connectors of the first type along one pair of opposite edge portions being arranged in a mirror-inverted manner relative to the corresponding connectors along the same pair of opposite edge portions of the second type of floorboard. The Official Action correctly notes that Terbrack does not disclose the step of joining a floorboard of the second type in a new row to a last laid floorboard of the first type in a preceding row. However, the Official Action asserts that this step would be obvious in view of Terbrack, simply

because Terbrack teaches two embodiments of a floorboard, and combining them would result in the same floor as claimed.

The position set forth in the Official Action for combining two different embodiments of Terbrack relies on impermissible hindsight reasoning, as it takes into account knowledge that was not within the level of ordinary skill in the art at the time the claimed invention was made and includes knowledge gleaned from Applicant's disclosure. Specifically, the Official Action notes that it would have been obvious to combine the two embodiments of Terbrack in the claimed manner because "the same resulting floor would be produced". This justification suggests that the reason to combine the two embodiments comes from the arrangement shown in Applicant's floor. Thus, the Examiner has admittedly relied upon only Applicant's disclosure for the motivation to combine the two separate embodiments.

The claimed arrangement pertains to a floor made of rectangular floorboards, where two different types of floorboards are joined together to form the floor. Terbrack discloses two different embodiments of a floorboard in Figures 11 and 23, but does not suggest that these different floorboards are joined to one another, or are even usable together, to form a floor. The notion of joining two separate types of floorboards together to form a floor is gleaned only from the Applicant's disclosure, and not from Terbrack or any other prior art reference. The proposed combination set forth in the Official Action is a result of impermissible hindsight reconstruction. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over Terbrack in view of Wasleff (U.S. Patent No. 1,787,027) and Shah (U.S. Patent Application Publication No. 2003/0221387). Claim 18, as amended, now recites that the rectangular floorboard include short sides having pairs of opposing connectors, and the these connectors are adapted for locking the floorboard only horizontally. This feature is similar to the feature recited in Claims 1 and 17, which have been indicated as allowable. Accordingly, withdrawal of this rejection is respectfully requested.

New Claim 19 depends from Claim 13 and recites the rectangular floorboard include short sides having pairs of opposing connectors, and the these connectors are adapted for locking the floorboard only horizontally. This feature is similar to the feature recited in Claims 1 and 17, which have been indicated as allowable. In

Terbrack, the connectors lock in the floorboards in both the horizontal and vertical directions. Accordingly, withdrawal of this rejection is respectfully requested.

For the reasons stated above, it is requested that all the rejections be withdrawn and that this application be allowed in a timely manner.

Should any questions arise in connection with this application or should the Office feel that a teleconference with the undersigned would be helpful in resolving any issues pertaining to this application, it is requested that the undersigned be contacted at the number indicated below.

Respectfully submitted,

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